



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,868	10/11/2004	Aldo A. Laghi	A34800-114166	5867

7590 09/04/2009
Robert S. Pippenger
Shumaker, Loop & Kendrick, LLP
P.O. Box 172609
Tampa, FL 33672-0609

EXAMINER

MULCAHY, PETER D

ART UNIT	PAPER NUMBER
----------	--------------

1796

MAIL DATE	DELIVERY MODE
-----------	---------------

09/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,868

Applicant(s)

LAGHI, ALDO A.

Examiner

Peter D. Mulcahy

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The rejection set forth under 35 USC 112 1st/2nd in the action mailed 8/20/08 is deemed proper and is herein repeated.

6. Applicant's arguments have been fully considered but have been found not persuasive.

7. In response to this rejection it is stated, "Applicant respectfully submits that the function of the particles is not so dependent on size, type or hardness that one of skill in the art would not be able to choose functional sizes, hardnesses or types without undue experimentation." It is further alleged that "One of skill in the art would thus realize that

the particles should have sizes on a scale much smaller than the scale of the bladder; that the particles be relatively inert with respect to each other and with respect to the fluid (if present at all) in the bladder such that cohesiveness or other interactions do not interrupt the ability of the particles to take on a new set; etc.” The fact remains that there is no description of the particles beyond “particle” as recited in the claims and specification. The fact that the bladder “takes a shape” in no way limits or enables the scope of the term. One looking to practice the claimed invention has no direction or idea as to which particles possess properties which would allow them to function in the intended manner. Further, the claims are indefinite in that it is unclear as to which “particles” fall within the scope of the claims. Point in fact, the patent to Matula Jr. et al. teaches “particulate matter” being incorporated in the bladder. Applicant attempts to distinguish this “particulate matter” from the claimed “particles” by alleging that this is “not particulate in the sense of the word understood by one of ordinary skill in the art.” This is unclear and unsupported by the record. Particles are often porous materials and/or sintered materials. There are no claim limitations that distinguish the claimed particles from the materials disclosed in the art. It would appear from applicant’s arguments that the claims are not enabled when the particles are porous or sintered materials. This substantiates the lack of enablement rejection. Further, it is unclear as to whether or not the claims read on porous or sintered materials. As such, it is appropriate to reject the claims as being indefinite.

Claim Rejections - 35 USC § 103

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matula et al. US 2006/0231103.
9. The rejection set forth under 35 USC 103 over Matula alone, in the paper mailed 8/20/09 is deemed proper and is herein repeated.
10. Applicant's remarks have been fully considered but have been found not persuasive.
11. Applicant's primary point of contention is that the Matula patent is directed a bladder that is filled with "foam or other particulate matter." It is alleged that this "refers to a material which is not particulate in the sense of the word understood by one of skill in the art." This is not persuasive. Given the breadth of the claimed term "particle" it is maintained that the porous and sintered materials can fall within the scope of the claim language. Applicant has failed to distinguish the prior art from the claim.
12. Applicant's then identify the channel through which gas can be pumped. It is alleged that this is incompatible with the interpretation of a particulate understood as a powder. While such may be the case, the claims are not limited to powders or particles of any specified size. The claim reads on sintered or compressed particles as suggested in the prior art.
13. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen US 2003/0122446.
14. The rejection as set forth under 35 USC 103 in the paper mailed 8/20/08 is deemed proper and is herein repeated.

15. Applicant's arguments have been fully considered and found not persuasive.

16. Applicant's appear to be reading limitations into the claims. It is alleged that the Chen patent shows gels and substrate materials that are interlocked. This is alleged to be distinct from the filled bladder as claimed. This is not persuasive. The fact that the substrate and gel may be interlocked is not germane to the patentability of the claimed invention. There are no limitations in the claims pending that distinguish over a gel interlocked with a substrate. Further, the presence of a gel is not excluded from the claimed invention. The claims do not distinguish from an additive contained within a gel. Chen shows particles M contained within an outer membrane G. This is seen to read on the bladder filled with particles as claimed.

17. Claims 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates US 6,672,548 in view of Chen US 2003/0122446.

18. Yates shows cushioning articles having a stretchable sheet 20, disposed over a cavity filled with particulates 38 and liquid 40. The stretchable sheet reads on the claimed elastomeric bladder. The liquids are seen to be the same species as the claimed plasticizers, column 3 line 64. The difference between the claimed invention and the cited art is that the art fails to specifically mention using the cushion article as a face seal interface. The patent does state that the use is not limited and that the cushions can be used "for any number of uses," see column 3 line 55.

19. Chen also shows articles wherein elastomeric membranes are filled with particulates. The uses for these articles can be seals face masks and other cushioning articles, [0260]-[0264]. The extensive listing of uses clearly indicates the art recognized

function of cushioning articles as seals for face masks. It would be obvious to use the cushioning article of Yates as a face seal interface. One would be motivated to use the cushioning article of Yates as a face seal given the teaching in Chen that cushioning articles can be used in face seal applications.

20. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates US 6,672,548 in view of Chen US 2003/0122446 as applied to claims 27,29 and 30 above, and further in view of Barnett et al. US 2006/0076018.

21. The Barnett patent shows face seal articles formulated from filled bladders, see [0051]. This portion of the patent is further cited as discussing the conventionality of using vacuum forming to fill a bladder with filling material. It would be obvious to use vacuum forming shown in Barnett for filling the cushion of Yates. One would be motivated to use vacuum forming as shown in Barnett to form the cushion of Yates given the art recognized conventionality of vacuum forming techniques when forming a filled bladder.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/
Primary Examiner, Art Unit 1796